

### **REMARKS**

The above amendments and these remarks are responsive to the Office action dated March 15, 2005. Prior to entry of this response, claims 1-15 were pending in this application. By this amendment, claim 7 is cancelled without prejudice and claims 16 and 17 are added. In the Office action: 1) claims 1-4, 6-7 and 12 are rejected under 35 U.S.C. 103(a) based on U.S. Pat. No. 6,132,268 to Uchino et al. in view of U.S. Pat. No. 5,511,505 to Kobayashi et al. and U.S. Pat. No. 4,382,797 to Blanchard; 2) claim 5 is rejected under 35 U.S.C. 103(a) based on Uchino in view of Kobayashi and Blanchard and further in view of U.S. Pat. No. 6,135,832 to Suzuki; 3) Claims 10 and 11 are rejected under 35 U.S.C. 103(a) based on Uchino in view of Kobayashi and Blanchard and further in view of U.S. Pat. No. 5,846,102 to Nitta et al.; and 4) claims 8-9 and 13-15 are objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form. Applicant thanks the Examiner for the careful consideration of the application and the indications of allowability. Applicant traverses the rejections, but nevertheless amends the claims as shown above in order to advance prosecution without delay. In view of the amendments above, and the remarks below, applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

#### **Rejections Under 35 U.S.C. § 103(a)**

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP 2143.

Independent claim 1 recites “a V-type four-cycle engine” that is “mounted within the body in such a manner that the crankshaft extends in a width direction of the body.” As acknowledged on page 3 of the Official action, “Uchino et al. does not disclose the engine being a V-type.” To the contrary, Uchino only discloses an “in-line type” engine. Col. 4, line 1. Furthermore, neither Kobayashi nor Blanchard disclose an engine mounted such that the crankshaft extends in a width direction. Therefore, none of the cited references individually teach all of the limitations of claim 1.

In order to properly reject claim 1 using a combination of Uchino, Kobayashi, and Blanchard, it must be shown that there is a teaching or motivation to replace the in-line engine of Uchino with either the V-type engine of Kobayashi or the V-type engine of Blanchard. Such a teaching or motivation must be found in Uchino, Kobayashi, Blanchard, or elsewhere in the prior art. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The teaching or motivation cannot come from the present application. *Id.*

The Official action does not identify any such teaching or motivation in Uchino, Kobayashi, Blanchard, nor any other prior art reference, because no such teaching or motivation exists in the prior art. Until the present invention, the benefits of a transversely mounted V-type engine were not appreciated.

In fact, the prior art specifically teaches away from using a V-type engine that is mounted transversely. For example, Kobayashi teaches that “the engine 35 is supported so that the crankshaft 39 rotates about a vertically extending axis. This provides a more compact assembly and also permits the watercraft to be relatively narrow.” Col. 9, lines 53-56 (emphasis added). The transversely extending crankshaft claimed in the present Application runs exactly contrary to the teachings of Kobayashi, because a transversely extending crankshaft is typically wider than a

vertically extending crankshaft, thus making it difficult to keep the watercraft narrow. A transversely extending crankshaft would render Kobayashi unsatisfactory for its intended purpose of “permitting the watercraft to be relatively narrow.” If a proposed modification renders the prior art unsatisfactory for its intended purpose, the required teaching or suggestion to make the proposed combination does not exist. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Accordingly, a prima facie case of obviousness has not been established.

For at least the above reason, rejection of claim 1 is improper and should be withdrawn. However, in order to advance prosecution without further delay, claim 1 is amended to recite that “the output shaft is provided to extend rearward through a rear wall of a crankcase such that its axial direction corresponds with the longitudinal direction of the body, and is rotatably supported by a rear wall of a crank chamber formed within the crankcase of the engine.” Neither Uchino, Kobayashi, nor Blanchard teach, or even suggest, such an arrangement. Therefore, as amended, claim 1 is believed to further distinguish the cited references, and rejection of claim 1 should be withdrawn for at least this additional reason.

Independent claim 1 has also been amended to correct a typographical error. Claim 1 originally recited a deck that covered the deck. Claim 1 now recites a deck that covers the hull.

Claims 2-6, and 8-15 depend from independent claim 1, and are allowable for at least the same reasons as explained above with reference to claim 1.

In addition, claim 11 is herein amended to further distinguish the cited references by reciting “a relay gear which is provided between the camshaft drive gear of the crankshaft and the camshaft driven gear of the camshaft and which is configured to allow rotation of the camshaft drive gear to be transmitted to the camshaft driven gear therethrough.” Such an arrangement can allow the length of the camshaft and the cylinder head to be reduced. This

arrangement is not taught in any of the cited references, and therefore rejection of claim 11 should be withdrawn for at least this additional reason.

Claim 12 is herein amended to recite “an exhaust system passage including exhaust pipes respectively extending from front-side and rear-side cylinder heads, and a collecting portion into which the exhaust pipes gather; and an air cleaner box provided in an air-intake system of the engine, wherein the collecting portion of the exhaust system passage is provided on one axial end portion side of the crankshaft and the air cleaner box is provided on an opposite axial end portion side of the crankshaft.” Such an arrangement helps balance the engine. This arrangement is not taught in any of the cited references, and therefore rejection of claim 12 should be withdrawn for at least this additional reason.

Claim 7 is herein cancelled without prejudice.

New claim 16 recites the same features as original claim 9, which was indicated to be allowable if rewritten in independent form. Accordingly, new claim 16 is allowable.

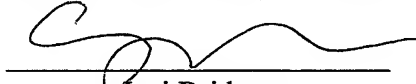
New claim 17 recites the same features as original claim 15, which was indicated to be allowable if rewritten in independent form. Accordingly, new claim 17 is allowable.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or

if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on July 12, 2005.

  
\_\_\_\_\_  
Josi Bridges

Respectfully submitted,

ALLEMAN HALL MCCOY RUSSELL &  
TUTTLE LLP



\_\_\_\_\_  
Mark D. Alleman

Registration No. 42,257

Customer No. 50488

Attorney/Agent for Applicant(s)/Assignee

806 S.W. Broadway, Suite 600

Portland, Oregon 97205

Telephone: (503) 459-4141

Facsimile: (503) 459-4142